

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on September 13, 2005. The application has been carefully reviewed in light of the Office action and interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-32, and 34-41 remain in this application. Claim 33 has been canceled. Claims 42-47 have been added.

Claims 1-4, 10-15, and 29-32 and 34-40 were rejected under 35 U.S.C. §102(e) as being anticipated by Fraccaroli (U.S. Pat. App. 2004/0002348). The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli and in view of various other cited references. For the following reasons, the rejections are respectfully traversed.

Claim 1 has been amended as discussed at the personal interview to include the step of "sending a message to at least one of said members if he is in the vicinity of another of said members of the common interest group" wherein "said message contains physical identification characteristics that enable the visual identification of the another of said members by the one of said members." Claim 40 recites similar limitations.

As discussed at the personal interview, Fraccaroli does not suggest sending a message comprising "physical identification characteristics" enabling "the visual identification" of one of the members, as recited in the claims. Accordingly, claims 1 and 40 are patentable over the reference. Claims 2-4, 10-15, and 29-39, which depend on claim 1, are thus patentable over the reference for at least the same reason as the parent claim.

The other cited references do not overcome the shortcomings of the Fraccaroli reference. Accordingly, claims 5-9 and 16-28 are patentable over the combination of references.

Additionally, as discussed at the personal interview, claim 41 has been amended to recite the step of “specifically billing a party for said sending of said message”. The Examiner cited, in the office action, a reference for teaching billing for a registration, but as discussed at the personal interview, none of the cited references suggest specifically billing for the sending of the message of the claim. Accordingly, claim 41 is patentable over the references.

Furthermore, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

Instead, the Examiner has merely listed a generalized benefit of the secondary reference, and has improperly attempted to use that benefit as motivation for modifying Fraccaroli. Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various

references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Finally, new claim 43 recites the steps of "storing a predetermined message criterion different from membership in said common interest group for determining when a message is sent to one of said members" and the step of "sending said message to the one of said members if he is in the vicinity of another of said members and only if said message criterion is satisfied". The cited references do not teach such a criteria, and thus claim 43, and dependent claims 44-47, are patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33835.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-1484
(216) 579-1700

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